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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/749,121	12/30/2003	Jeffrey O. Saunders	VPI/02-05 US	3285
27916	7590	08/16/2007	EXAMINER	
VERTEX PHARMACEUTICALS INC. 130 WAVERLY STREET CAMBRIDGE, MA 02139-4242				BARKER, MICHAEL P
ART UNIT		PAPER NUMBER		
		1626		
MAIL DATE		DELIVERY MODE		
		08/16/2007 PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	10/749,121	SAUNDERS ET AL.
	Examiner Michael P. Barker	Art Unit 1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 6/29/07, Amendment After Non-Fin. Rej.
- 2a) This action is **FINAL**.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) Claims 75, 80-85, and 87-89 is/are pending in the application.
  - 4a) Of the above claim(s) 75 and 80-85 is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 87-89 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application |
|  | 6) <input type="checkbox"/> Other: _____                          |

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## DETAILED ACTION

**Claims 75, 80-85, and 87-89** are pending in this Application. Applicant has canceled **Claims 1-74, 76-79, and 86** and amended **Claims 75 and 80-85**. Claims 75 and 80-85 are withdrawn. **Claims 87-89** will be examined.

### *Response to Remarks*

Applicant is correct in pointing out the Examiner's mistake in regard to the 35 U.S.C. 102(e) rejection over Kenny, et al. Applicant's amendments overcome the rejection previously put forth under 35 U.S.C. 102(b) (Bright, et al.). The rejections over Kenny, et al. and Bright, et al. are both withdrawn. However, Claims 87-89 are not free of the prior art.

### *Claim Rejections*

#### 102(e)

the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 87-89** are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Publication No. 2004023974 A1, published February 5, 2004. Specifically, the '974 publication discloses Example 37 at p. 49, which is Applicant's compound "I-12" disclosed in **Claim 87**. The compounds of the '974 publication may be employed in pharmaceutical compositions [0084], p. 3.

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**103(a)**

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 87-89** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Publication No. 2004023974 A1, published February 5, 2004.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

***Determining the scope and contents of the Prior Art***

The '974 publication discloses Example 37 at p. 49, a compound alleged to be useful for the treatment of conditions associated with PTPase activity.

***Ascertaining the Differences Between the Prior Art and the Claims at Issue***

**Positional Isomerism:**

Applicant's instantly claimed invention, specifically **Claim 87**, formula I-3 differs from Example 37 of the '974 publication by the position of the methyl ester on the benzoic acid moiety.

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*Resolving the Level of Ordinary Skill in the Pertinent Art*

The level of ordinary skill in the pharmacological arts is extremely high. Because of the high level of skill and predictability of the pharmacological arts, there is nothing unobvious in substituting the claimed isomer, I-3, for the structurally similar isomer taught by the '974 publication, Example 37 (also, instantly claimed I-12). Structurally similar compounds suggest one another and are expected to behave similarly in similar environments.

*Conclusion*

Applicant's amendments necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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***Telephone Inquiry***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael P. Barker whose telephone number is (571) 272-4341. The examiner can normally be reached on Monday-Friday 8:00 AM- 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Joseph K. McKane, can be reached at (571) 272-0699. The unofficial fax phone for this group are (571) 273-8300.



REBECCA ANDERSON  
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